

Appl. No. 09/680,162  
Atty. Docket No. 7886  
Amdt. dated December 11, 2003  
Reply to Office Action of September 11, 2003  
Customer No. 27752

### REMARKS

Claims 1-6, and 8-23 are pending in the present application. No additional claims fee is believed to be due.

Claim 7 has been canceled without prejudice.

Claim 1 has been amended to more clearly claim the invention of the present application. Claim 1 has been amended to more specifically claim the present invention. Support for the amendment of Claim 1 is discussed in more detail below.

It is believed these changes do not involve any introduction of new matter. Consequently, entry of these changes is believed to be in order and is respectfully requested.

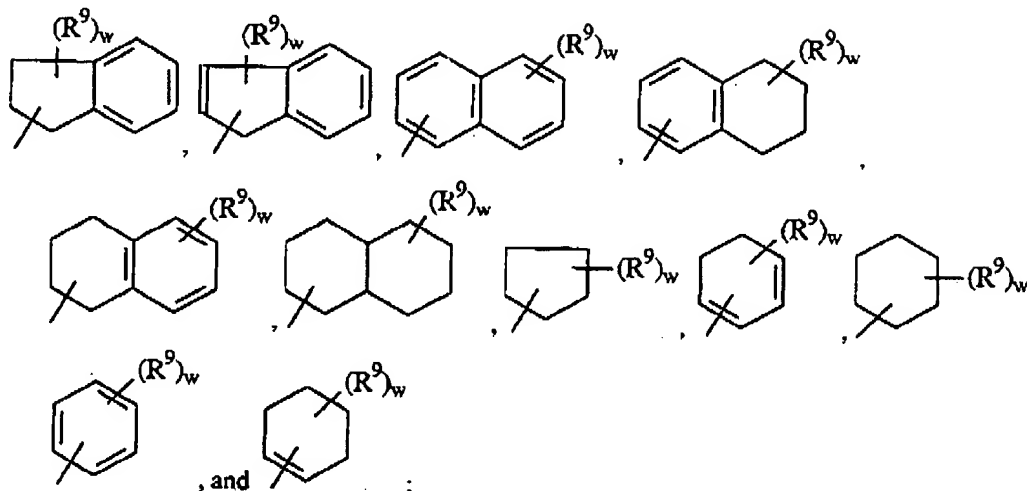
Applicants thank the Examiner for the withdrawal of the objection to claim 23. Applicants further thank the Examiner for the withdrawal of the rejections of Claims 10, 11, and 13 under 35 U.S.C. §112, first paragraph and second paragraph; Claims 1-7, 12, and 16-23 under 35 U.S.C. § 102(b) as anticipated and alternatively under 103(a) as being obvious over Beyer et al, DE 2,252,186; Claims 1-7, 12 and 16 under 35 U.S.C. § 102(b) as being anticipated or in the alternative, under 103(a) as obvious over Wolf et al., WO 95/13260.

The office action has objected to the amended filed June 9, 2003, under 35 U.S.C. § 132 for introducing new matter, specifically (ii)-(v) of the variable R<sup>2</sup> in Claim 1, 6, and 16. Applicants submit support in the specification for Claim 1 groups (ii)-(v) as follows:

(ii) 4 to 30 membered substituted or unsubstituted, unsaturated cyclic or aromatic hydrocarbon radical

Page 9, lines 7-16, wherein R<sup>2</sup> is  $\text{---}(\text{CH}_2)_y\text{---X}$ ; y=0, and X is selected from the group consisting of:

Appl. No. 09/680,162  
 Atty. Docket No. 7886  
 Amct. dated December 11, 2003  
 Reply to Office Action of September 11, 2003  
 Customer No. 27752



wherein each  $R^9$  is independently selected from the group consisting of hydrogen, linear or branched, saturated or unsaturated, substituted or unsubstituted, aliphatic hydrocarbon or alkoxy radical having from about 1 to about 10 carbon atoms, or  $R^9$  is a saturated or unsaturated, substituted or unsubstituted, alicyclic or aromatic hydrocarbon radical having, from about 1 to about 10 carbon atoms, which is fused to the ring;  $w$  is an integer from 1 to 3..

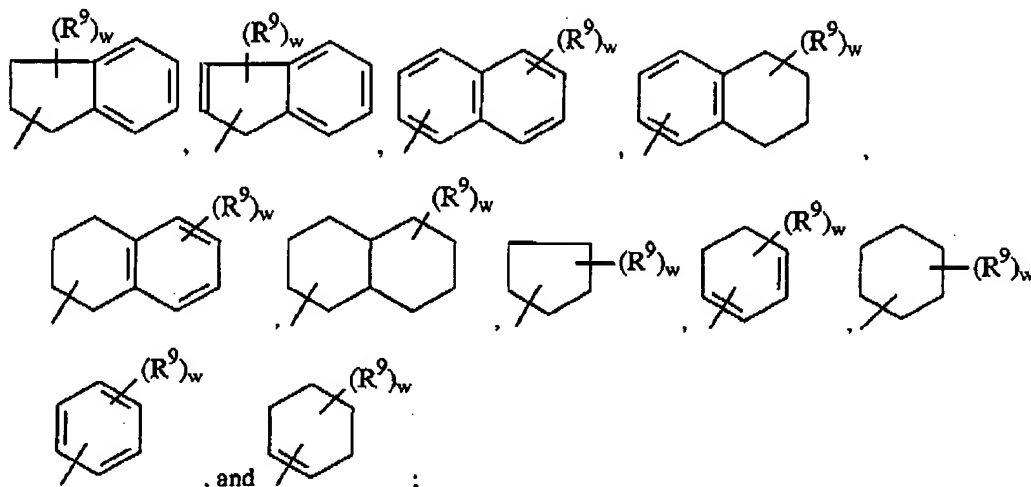
(iii) 7 to 13 membered substituted, or unsubstituted polycyclic ring

Page 9, lines 1-6

(iv) substituted or unsubstituted saturated cyclic hydrocarbon radical having from 5 to 30 carbon atoms, wherein when the cyclic hydrocarbon radical is an unsubstituted 6 carbon radical or a substituted 7 or 8 carbon radical,  $R$  is a linear or branched, saturated or unsaturated, substituted or unsubstituted aliphatic radical having from about 1 to about 5 carbon atoms

page 9, line 7 – page 10, line 4, wherein  $R^2$  is  $-(CH_2)_y-X$ ,  $y=0$ , and  $X$  is selected from the group consisting of:

Appl. No. 09/860,162  
Atty. Docket No. 7886  
Amdt. dated December 11, 2003  
Reply to Office Action of September 11, 2003  
Customer No. 27752

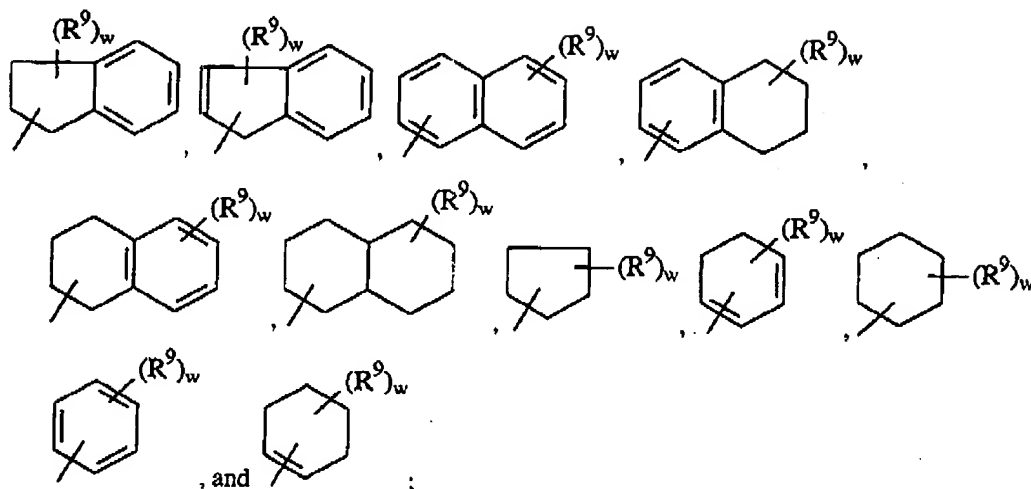


wherein each R<sup>9</sup> is independently selected from the group consisting of hydrogen, linear or branched, saturated or unsaturated, substituted or unsubstituted, aliphatic hydrocarbon or alkoxy radical having from about 1 to about 10 carbon atoms, or R<sup>9</sup> is a saturated or unsaturated, substituted or unsubstituted, alicyclic or aromatic hydrocarbon radical having, from about 1 to about 10 carbon atoms, which is fused to the ring; w is an integer from 1 to 3.

**Page 3, lines 24-27.**

(v) substituted or unsubstituted saturated cyclic hydrocarbon radical having from 5 to 30 carbon atoms, wherein when the cyclic hydrocarbon radical is an unsubstituted cyclohexyl radical or a methyl or ethyl substituted cyclohexyl radical, R is a branched, saturated or unsaturated, substituted or unsubstituted aliphatic radical having from about 23 to about 30 carbon atoms  
page 9, line 7 – page 10, line 4, wherein  $R^2$  is  $-(CH_2)_y-X$ ,  $y=0$ , and X is selected from the group consisting of:

Appl. No. 09/660,162  
 Atty. Docket No. 7886  
 Amdt. dated December 11, 2003  
 Reply to Office Action of September 11, 2003  
 Customer No. 27752



wherein each  $R^9$  is independently selected from the group consisting of hydrogen, linear or branched, saturated or unsaturated, substituted or unsubstituted, aliphatic hydrocarbon or alkoxy radical having from about 1 to about 10 carbon atoms, or  $R^9$  is a saturated or unsaturated, substituted or unsubstituted, alicyclic or aromatic hydrocarbon radical having, from about 1 to about 10 carbon atoms, which is fused to the ring;  $w$  is an integer from 1 to 3.

And Page 3, lines 24-27 for the description of the R moiety.

Applicants submit that Claim 6 has support in the specification at page 5, lines 13-19.

Applicants submit that Claim 16 has support in the specification at page 5, lines 13-19.

#### Rejection Under 35 U.S.C. §112, First Paragraph

The Office Action States Claims 1-23 are rejected under 35 U.S.C. §112, First Paragraph as failing to comply with the written description requirement. Specifically, the newly added groups (ii)-(v) for the variable  $R^2$  in instant claims 1, 6, and 16.

An applicant's specification must convey with reasonable clarity to those skilled in the art that, as of the filing date sought, he or she was in possession of the invention, i.e., whatever is now claimed. Vas-Cath, Inc. v. Mahurkar, 19 USPQ2d 1111, 1117 (Fed. Cir. 1991). The test for sufficiency of support in a parent application is whether the disclosure of the application relied upon "reasonably conveys to the artisan that the inventor had possession at that time of the later claimed subject matter." Ralston Purina Co. v. Far-Mar-Co., Inc., 227 USPQ 177, 179 (Fed. Cir. 1985). The subject matter of the claim need not be described literally (i.e., using the same terms

Appl. No. 09/660,162  
Atty. Docket No. 7886  
Amdt. dated December 11, 2003  
Reply to Office Action of September 11, 2003  
Customer No. 27752

or in *haec verba*) in order for the disclosure to satisfy the description requirement. See MPEP §2163.02. The inquiry into whether the description requirement is met must be determined on a case-by-case basis and is a question of fact. *In re Wertheim*, 191 USPQ 90, 96 (CCPA 1976). The examiner has the initial burden of presenting evidence or reasons why persons skilled in the art would not recognize in an applicant's disclosure a description of the invention defined by the claims. *In re Wertheim*, 191 USPQ at 98.

Applicants submit that the specification conveys with reasonable clarity to those skilled in the art that, as of the filing date sought, what was in possession of the invention, i.e., whatever is now claimed. In the decision of *Ex parte Sorenson*, 3 USPQ2d 1462 (Bd. Pat. App. & Inter. 1987), it was decided that the subgeneric language of "aliphatic carboxylic acid" and "aryl carboxylic acid" did not violate the written description requirement because species falling within each subgenus were disclosed as well as the generic carboxylic acid. Similarly, Applicants submit that the narrowing of Claim 1 for the claim of the R<sup>2</sup> moiety from:

(ii) linear or branched, saturated or unsaturated, substituted or unsubstituted, cyclic or acyclic, aliphatic or aromatic hydrocarbon radicals having from about 1 to about 30 carbon atoms;

to claim the subgeneric language of:

(ii) unsaturated cyclic or aromatic hydrocarbon radicals having from about 4 to about 30 carbon atoms; and

(iii) 7 to 13 membered substituted, or unsubstituted polycyclic ring;

(iv) substituted or unsubstituted cyclic hydrocarbon radical having from 5 to 30 carbon atoms, wherein when the cyclic hydrocarbon radical is an unsubstituted 6 carbon radical or a substituted 7 or 8 carbon radical, R is a linear or branched, saturated or unsaturated, substituted or unsubstituted aliphatic radical having from about 1 to about 5 carbon atoms; and

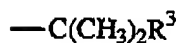
(v) substituted or unsubstituted cyclic hydrocarbon radical having from 5 to 30 carbon atoms, wherein when the cyclic hydrocarbon radical is an unsubstituted cyclohexyl radical or a methyl or ethyl substituted cyclohexyl radical, R is a branched, saturated or unsaturated, substituted or unsubstituted aliphatic radical having from about 23 to about 30 carbon atoms;

Such that the subspecies of (ii)-(v) are within the generic description of original subgroup (ii) and original R moiety definition. With respect to changing numerical range limitations, the analysis must take into account which ranges one skilled in the art would consider inherently supported by

Appl. No. 09/660,162  
Atty. Docket No. 7886  
Amdt. dated December 11, 2003  
Reply to Office Action of September 11, 2003  
Customer No. 27752

the discussion in the original disclosure. Applicants submit that the numerical range limitations are ranges one skilled in the art would consider inherently supported by the discussion in the original disclosure. Therefore, Applicants submit that the Examiner has failed to present a prima facie case for failing to comply with the written description requirement.

Applicants further submit that Claims 6 and 10 are also contain subgeneric language of the original generic subgroup wherein  $R^2$  is a hydrocarbon radical of the formula:



wherein the generic description of  $R^3$  is an aliphatic radicals or aromatic hydrocarbon radicals having from about 1 to about 30. Claims 6 and 16 claims an amended subgeneric  $R^3$  as a cyclic aliphatic radicals having from about 5 to about 30 carbon atoms or aromatic hydrocarbon radicals having from about 6 to about 30 carbon atoms. Applicants submit that the subgeneric  $R^3$  is recognizable by one of skill in the art. Applicants further submit that the numerical range limitations are ranges one skilled in the art would consider inherently supported by the discussion in the original disclosure. Therefore, Applicants submit that the Examiner has failed to present a prima facie case for failing to comply with the written description requirement.

#### Double Patenting Rejection

The Office Action has maintained rejected Claims 1-23 are provisionally rejected under the judicially created doctrine of obviousness-type double patenting in view of Claims 1-31 of co-pending application No. 09/733,450. Applicants will submit a terminal disclaimer to overcome the double patenting rejection of Claims 1-23, if and when the Examiner indicates allowable subject matter.


#### Conclusion

In light of the above remarks, it is requested that the Examiner reconsider and withdraw the objection and rejection under 35 U.S.C. § 132 and §112, first paragraph. Early and favorable action in the case is respectfully requested.

Applicants have made an earnest effort to place their application in proper form and to distinguish the invention as now claimed from the applied references. In view of the foregoing, Applicants respectfully request reconsideration of this application, entry of the amendments presented herein, and allowance of Claims 1-6 and 9-41. If, prior to allowance, any outstanding issues exist, Applicants' attorney would welcome the opportunity to resolve such issues via a phone interview.

Appl. No. 09/860,162  
Atty. Docket No. 7886  
Amdt. dated December 11, 2003  
Reply to Office Action of September 11, 2003  
Customer No. 27752

Respectfully submitted,  
Mark Robert Sivik, et al.

By   
Laura R. Grunzinger  
Attorney for Applicant(s)  
Registration No. 47,616  
(513) 627-1888

December 11, 2003  
Customer No. 27752